

REMARKS/ARGUMENTS

The office action of April 6, 2006 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 2, 5-7, 9, 10, 13, 15, 16 and 19 remain in this application. Claims 1, 3, 4, 8, 11, 12, 14, 17, 18 and 20 have been canceled without prejudice or disclaimer and new claims 21-26 have been added.

Preliminarily, applicants wish to thank Examiner Tsui and Examiner Hong for the courtesies extended to the undersigned during the personal interview on June 29, 2006.

The Abstract of the Disclosure stands objected to as being too short. Applicants have amended the Abstract herein.

The title of the invention stands objected to as not descriptive. As kindly suggested by the Examiner, Applicants have amended the title of the invention.

Also, applicants have amended the specification to correct various informalities discovered therein. No new matter has been added. In addition, applicants have amended Fig. 1 to replace a duplicate numeric label, hard disk interface label 192, with the label "172" as the same label 192 is used for the optical disk. A corresponding amendment to the specification has also been made.

Claims 1, 2, 5, 8, 11, 14 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent no. 6,279,014 B1 to Schilit et al. ("Schilit"). Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schilit in view of U.S. patent no. 6,909,805 B2 to Ma et al. ("Ma"). Claims 6, 7, 10, 12, 13, 16, 18, 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schilit in view of U.S. publication no. 2004/0216032 A1 to Amitay et al. ("Amitay"). Claims 9 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schilit in view of U.S. publication no. 2002/0089551 A1 to Hugh et al. ("Hugh"). Applicants respectfully traverse these rejections.

Claims 9, 10, 15 and 16

Applicants have rewritten claims 9 and 15 in independent form, and submit that they are patentably distinct from the combination of Schilit and Hugh.

The action acknowledges that Schilit does not teach or suggest filtering the combination of at least two sets. To overcome this deficiency, the action relies on Hugh at paragraph [0061].

As discussed during the interview, applicants submit that Hugh at paragraph [0061] merely describes combining matches (apparently thoughts) and then using that combination to filter. In addition, Hugh describes filtering by comparing the names of the thoughts. Significantly, Hugh lacks a teaching or suggestion of filtering the combination of at least two sets as recited in claims 9 and 15. As such, the combination of Schilit and Hugh, even if proper, does not result in the inventions of claims 9 and 15.

Moreover, applicants submit that, even assuming that the combination of Schilit and Hugh somehow results in the invention of claims 9 and 15, the combination is improper. The action alleges that one skilled in the art would have combined Schilit and Hugh to provide a filtered result that can be tailored to a user's display preferences. However, as discussed during the interview, applicants submit that Schilit already allows the filtered result to be tailored to a user's preference (by filtering). Thus, one of ordinary skill in the art would not have had a need or been otherwise motivated to combine Hugh with Schilit, because the filtering disclosed in Schilit already achieved a comparable result. For at least this reason, the combination of Schilit and Hugh would not have been proper.

For at least the reasons set forth above, claims 9 and 15, and claims 10 and 16, which respectively depend therefrom, are patentable over the applied art.

Claims 13 and 19

As amended, claims 13 and 19 call for, among other features, storing associations regarding at least two documents from which an annotation originates, wherein selection of the annotation accesses the at least two documents to display the annotation. As discussed during the interview, the combination of Schilit and Amitay neither teaches nor suggests at least two documents from which an annotation originates and wherein selection of the annotation accesses the at least two documents as recited in claims 13 and 19. In contrast, Amitay at paragraph [71] describes nothing more than each annotation including a link to the document to which the annotation relates, and more particularly to the specific location in the document at which the

annotation was recorded. As such, the combination of Schilit and Amitay, even if proper, does not result in the inventions of claims 13 and 19.

Claims 2, 5-7, and 21-26

Independent claim 21 calls, for among other features, a processor for creating a renderable image having clips, wherein at least one of the clips is a combination of two or more annotations, the processor executing instructions including encompassing first content and an associated annotation in a first bounding box, encompassing second content and an associated annotation in a second bounding box, and combining the first bounding box and the second bounding box to form one of the clips. Applicants submit that claim 21 is different from any of the cited art alone or in combination including the combination of Schilit and Ma. As discussed during the interview, the combination of Schilit and Ma does not teach or suggest encompassing content and annotations in bounding boxes and then combining the bounding boxes with both the annotations and contents. Indeed, Ma merely uses bounding boxes to group printed text lines in order to separate the handwritten annotations. *See* col. 7, lines 32-60. There is no teaching or suggestion in Ma that content and an associated annotation are encompassed in a bounding box. Nor is there any teaching or suggestion of combining a first bounding box encompassing first content and an associated annotation with a second bounding box encompassing second content and an associated annotation. For at least these reasons, the cited art alone or in combination fails to result in the claim 21 invention.

Independent claim 23 is similar to claim 21 in many respects, and is considered patentably distinct from the cited art for substantially the same reasons as claim 21. Claim 22, which depends from claim 21, and claims 2, 5-7, and 24-26, which ultimately depend from claim 23, are patentably distinct from the cited art for the same reasons as their ultimate base claim and further in view of the additional advantageous features recited therein.

CONCLUSION

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

Respectfully submitted,

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Dated: July 5, 2006

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Appln. No.: 10/777,046
Amendment dated July 5, 2006
Reply to Office Action of April 6, 2006

Amendments to the Drawings:

The attached sheet of drawings includes changes to Fig. 1. This sheet, which includes Fig. 1, replaces the original sheet including Fig. 1. In Fig. 1, the label 192 associated with the Hard Disk Interface has been replaced with label 172.

Attachment: Replacement Sheet
Annotated Sheet Showing Changes

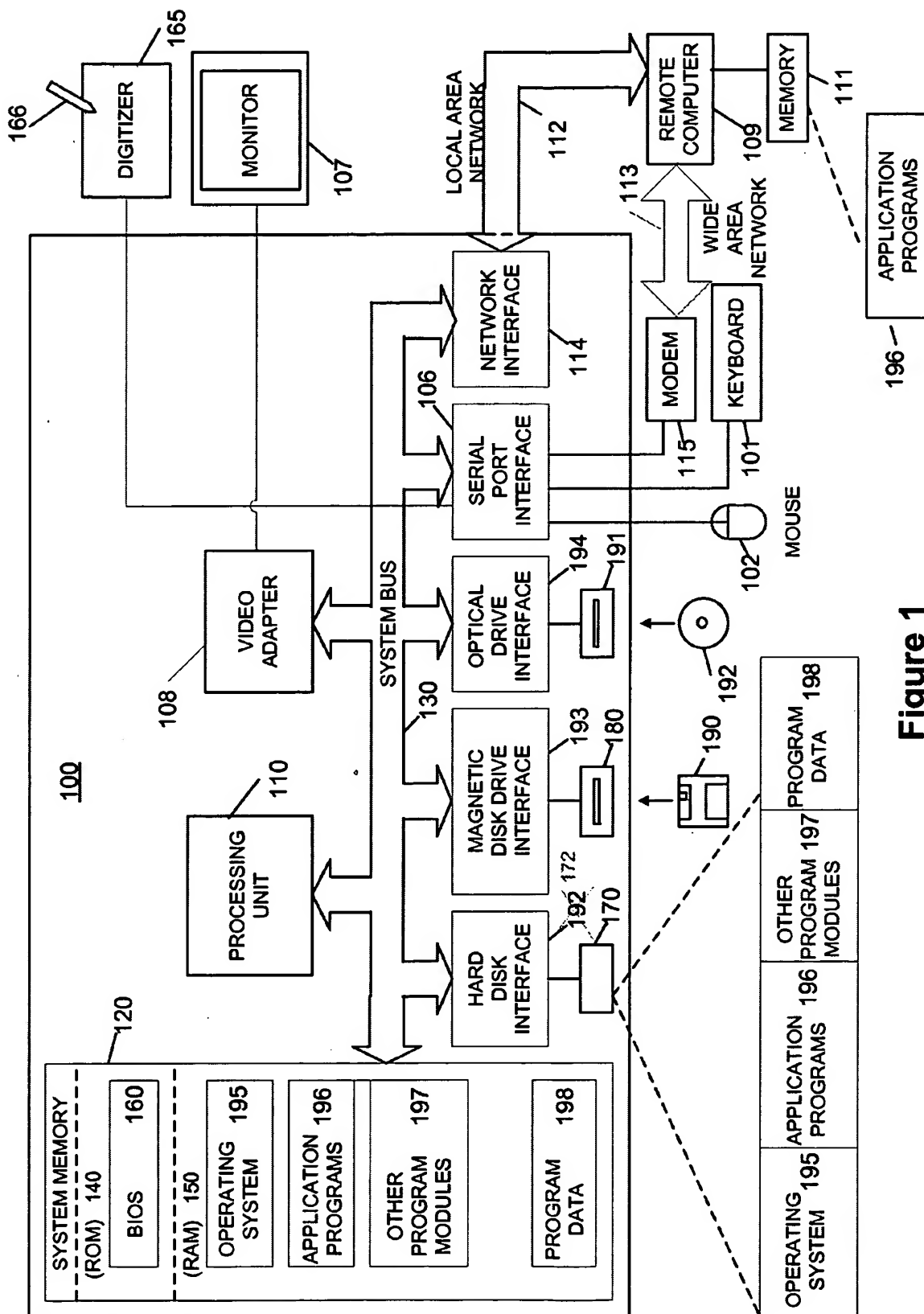


Figure 1